

## **REMARKS**

In response to the final Office Action dated July 24, 2009, the Assignee respectfully requests continued examination and reconsideration based on the above amendments and on the following remarks.

Claims 1, 5-14, 36, and 39-46 are currently pending in this application.

### **Rejection of Claims under § 103 (a)**

The Office rejected claims 1, 5-6, 36, 40-41, and 44-46 under 35 U.S.C. § 103 (a) as being unpatentable over U.S. Patent 6,005,861 to Humpleman in view of U.S. Patent 6,493,875 to Eames, *et al.* and further in view of U.S. Patent 6,732,366 to Russo.

*Humpleman* with *Eames*, however, teaches away and cannot support a *prima facie* case for obviousness. The M.P.E.P. expressly explains several situations in which a reference “teaches away,” including when a proposed modification “render[s] the prior art unsatisfactory for its intended purpose” or when the proposed modification “change[s] the principle of operation of a reference.” See M.P.E.P. § 2145 (X)(D). If *Humpleman* is combined with *Eames*, as the Office proposes, then *Eames*’s principle of operation must be changed, and these changes render *Eames* unsatisfactory for its intended purposes. Indeed, as the following paragraphs will explain, *Humpleman*’s entire teaching of distributing digital signals from each network interface unit over an Ethernet network must be **eliminated**. *Humpleman*’s entire teaching of connecting each network interface unit to the switch hub must also be **eliminated**. Because these changes are not permitted, the proposed combination of *Humpleman* with *Eames* cannot support a *prima facie* case for obviousness, so the Office is required to remove the § 103 (a) rejection of claims 1, 5-6, 36, 40-41, and 44-46.

*Humpleman*’s principle of operation is first explained. Separate network interface units each connect to a different external network. See U.S. Patent 6,005,861 to Humpleman at

column 3, lines 20-35. Digital signals from each network interface unit are distributed over an Ethernet network. *See id.* at column 3, lines 49-52. Each network interface unit connects to a scalable switch hub and thus to terminal units. *See id.* at column 3, lines 52-55. **A gateway connects to the Ethernet network and to a “local peripheral network” to accommodate “very high bit rate” video devices, audio devices, printers, and other “high bandwidth” peripherals.** *Id.* at column 4, lines 16-32 (emphasis added). Each device’s “Ethernet port” is connected by twisted-pair cabling to the switch hub. *See id.* at column 4, lines 38-56.

*Eames’s* principle of operation is entirely different. *Eames* describes a wireless gateway for use in a residence. *See* U.S. Patent 6,493,875 to *Eames, et al.* at column 1, lines 39-45. *Eames’s* FIG. 3 illustrates a circuit architecture for the wireless gateway. *See id.* at column 2, lines 37-39. The gateway has a “network interface module” that connects to the access network. *See id.* at column 4, lines 58-60. The network interface module interfaces with a motherboard that contains a processor, memory, MPEG processor, and an Ethernet block. *See id.* at column 5, lines 1-7. “A set of buses” routes information “within [the] gateway.” *See id.* at column 5, lines 25-29. “[O]ptional modules” all connect to a “control bus in addition to being connected to at least one other bus.” *See id.* at column 5, lines 29-35.

The Office must now realize that “impermissible changes” are required. If *Humpleman* is combined with *Eames*, as the Office proposes, then *Humpleman’s* principle of operation must be drastically changed. *Humpleman’s* network interface units are distributed over an Ethernet network, but *Eames’s* network interface module connects to *Eames’s* “set of buses” and to *Eames’s* motherboard. The proposed combination of *Humpleman* with *Eames*, then, would require **eliminating** *Humpleman’s* entire teaching of distributing digital signals from each network interface unit over an Ethernet network. Indeed, *Humpleman’s* entire teaching of connecting each network interface unit to the switch hub must be **eliminated**. These changes are so drastic that *Humpleman* is unsatisfactory for its intended purpose of distributing digital signals to the home Ethernet network.

Even more changes are required. If *Humpleman* and *Eames* are combined, then *Eames*'s principle of operation must be drastically changed. *Humpleman*'s gateway, that connects *Humpleman*'s Ethernet network to *Humpleman*'s "local peripheral network," must be replaced with *Eames*'s wireless gateway having a set of buses. If *Humpleman* and *Eames* are combined, then *Eames*'s network interface module must be **eliminated** to connect to *Humpleman*'s Ethernet network. Conversely, if *Humpleman*'s Ethernet network connects to *Eames*'s Ethernet port 438, then *Eames*'s entire teaching of connecting the "network interface module" to the access network must be **eliminated**.

*Humpleman* with *Eames*, then, teaches away. The proposed combination of *Humpleman* with *Eames* requires **eliminating** significant portions of *Humpleman*'s teachings, and these changes render *Humpleman* unsatisfactory for its intended purpose of distributing digital signals to the home Ethernet network. *Eames*'s principle of operation must, additionally or alternatively, be drastically changed and entire teachings must be **eliminated**. Because the patent laws forbid changing a principle of operation to support a *prima facie* case, the Office is required to remove the § 103 (a) rejection of claims 1, 5-6, 36, 40-41, and 44-46.

#### **Rejection of Claim 39 under § 103 (a)**

Claim 39 was rejected under 35 U.S.C. § 103 (a) as being obvious over *Humpleman*, *Eames*, and *Russo* and further in view of U.S. Patent 4,809,069 to Meyer. Claim 39, though, depends from independent claim 36. The paragraphs above explained how any combination involving *Humpleman* with *Eames* teaches away. The rejection of claim 39 must fail, so the Office is thus respectfully requested to remove the § 103 (a) rejection of this claim.

#### **Rejection of Claims 7 & 42 under § 103 (a)**

The Office also rejected claims 7 and 42 under 35 U.S.C. § 103 (a) as being obvious over *Humpleman*, *Eames*, and *Russo* and further in view of U.S. Patent 5,768,527 to Zhu, *et al.* Claims 7 and 42, however, depend, respectively, from independent claims 1 and 36. The

paragraphs above explained how any combination involving *Humpleman* with *Eames* teaches away. The rejection of these claims must fail, so the Office is respectfully requested to remove the § 103 (a) rejection of these claims.

**Rejection of Claims 8-14 & 43 under § 103 (a)**

Claims 8-14 and 43 were also rejected under 35 U.S.C. § 103 (a) as being obvious over *Humpleman*, *Eames*, and *Russo* and further in view of U.S. Patent 6,104,861 to Tsukagoshi and further in view of U.S. Patent 5,473,772 to Halliwell, *et al.*

Claims 8-14 and 43, though, depend from either independent claim 1 or 36. The paragraphs above explained how any combination involving *Humpleman* with *Eames* teaches away. The rejection of these claims must fail, so the Office is respectfully requested to remove the § 103 (a) rejection of these claims.

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If any questions arise, the Examiner is invited contact the undersigned at (919) 469-2629 or [scott@scottzimmerman.com](mailto:scott@scottzimmerman.com).

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Scott P. Zimmerman', with a stylized flourish at the end.

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